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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/689,463	10/12/2000	Terence Michael Hedley	UDL 2 0002-1	2659

7590 02/05/2003

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EXAMINER

JUSKA, CHERYL ANN

ART UNIT PAPER NUMBER

1771

DATE MAILED: 02/05/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/689,463

Applicant(s)

HEDLEY, TERENCE MICHAEL

Examiner

Cheryl Juska

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21,22,24-32 and 34-100 is/are pending in the application.
- 4a) Of the above claim(s) 24-32,34,35,37 and 88-100 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21,22,36 and 38-87 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☒ Certified copies of the priority documents have been received in Application No. 09/029,402.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. Preliminary Amendment A has been entered. The abstract and the specification have been amended as requested. Claims 1-20, 23, and 33 have been cancelled, claims 21, 22, 24, and 26-32 have been amended, and new claims 34-100 have been added. Thus, the pending claims are 21, 22, 24-32, and 34-100.

### ***Election/Restrictions***

2. Applicant's election without traverse of Group I, claims 21, 22, and 36-87, in Paper No. 5 is acknowledged. Claims 24-32, 34, 35, and 88-100 are withdrawn as being drawn to a non-elected invention. It is noted that claim 37 was inadvertently placed in Group I. However, claim 37 actually depends from claim 34 and, as such, is withdrawn along with the Group III claims, 34 and 35. Thus, the claims being examined are 21, 22, 36, and 38-87.

### ***Claim Objections***

3. Claims 46 and 71 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claims, or amend the claims to place the claims in proper dependent form, or rewrite the claims in independent form. Said claims are not further limiting due to the recitation that the natural fiber is a viscose fiber. Viscose, or regenerated cellulose, fibers are not natural fibers but

rather are synthetic fibers. It is suggested that viscose be deleted from the claims or that the term natural fiber be amended to cellulosic fiber.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 47, 50, 53, 54, and 63 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Claims 47, 50, 53, and 54 are indefinite for the use of the term "preferably..." A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).
7. Claim 54 is indefinite because it is unclear if the claimed thickness is the thickness of the backing layer at the periphery or at the center.

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8. Claim 63 is indefinite for the use of the relative phrase "improved tear resistance." It is unclear what said improvement is in comparison to.

### *Claims*

9. Independent claim 21 is drawn to a mat produced by specific process. With respect to the limitations describing the method of making the mat, it is noted that said limitations are not given patentable weight at this time. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. The final product of said process is a mat having a fabric layer which is bonded to a cured rubber backing, wherein said backing has an integral thickened peripheral region that extends outwardly beyond said fabric layer. Claim 22 limits the backing to having holes therein. Claim 36 limits the thickness of said peripheral region to being approximately double towards the periphery of said mat.

Independent claim 38 is drawn to a mat having a fabric layer and a rubber backing layer bonded together, wherein said rubber backing has an integral peripheral region beyond said fabric layer having a thickness with increases towards the periphery of said mat. The limitation of claim 39 is analogous to the limitation of claim 36. Claims 40-42 limit the fabric layer to being a pile fabric, tufted pile fabric, and cut and/or looped pile fabric, respectively. Claims 43 and 44 limit the fabric layer to being a synthetic fiber of polyamide, polyester, polypropylene, or a blend thereof. Claims 45 and 46 limit the fabric layer to being cotton or viscose. Claim 47 limits the fabric layer to having a basis weight of 300-1200 g/m<sup>2</sup>. Claims 48-50 limit the fabric layer to having a woven or nonwoven substrate of polyester or polypropylene fibers and a basis

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weight of 70-300 g/m<sup>2</sup>. Claims 51-54 limit the rubber backing to being a natural or synthetic rubber, such as a nitrile rubber, SBR, or blend thereof, wherein said backing layer has a hardness of 35-75 IRHD and a thickness of 0.5-3.0 mm. Claims 55 and 56 limit the backing to having surface formations of raised projections and/or indentations or cleats, a pattern, and/or a logo. Claims 57-60 limit the backing layer to having perforations, rounded corners, a concave edge, and a clean edge, respectively. Claims 61 and 62 limit the peripheral region to a width of approximately 2 cm and the mat to a size of 120 x 80 cm, respectively.

10. Independent claim 63 is drawn to a mat having a fabric layer and a rubber backing layer bonded together, wherein the rubber backing has an integral peripheral region beyond the fabric layer with increase tear resistance. The limitations of claims 64-87 are analogous to the limitations of claims 39-62.

***Claim Rejections - 35 USC § 102 and/or 103***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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13. Claims 38-46, 48, 49, 51, 54-56, 58, 63-71, 73, 74, 76, 79-81, and 83 are rejected under 35 USC 102(b) as being anticipated by US 4,491,556 issued to Fujii et al.

14. Claims 21 and 36 are rejected under 35 USC 102(b) as being anticipated by, or in the alternative, under 35 USC 103(a) as being obvious over US 4,491,556 issued to Fujii et al.

Fujii discloses a carpet mat comprising a carpet base and a resin backing fused thereto (col. 1, lines 16-65 and col. 2, lines 18-27). The mat has a thickened peripheral region and may have ridges or single-standing projections on the backside of said resin backing (Figures 12 and 16). The thickened edges improve the appearance of the mat, increase the strength thereof, and prevent fraying (col. 4, lines 5-9). The ridges, made from grooves in the mold, prevent slippage of the mat while in use and may have a triangular, rectangular, or circular cross-section (col. 4, lines 20-28). The single-standing projections, or cleats, may be conical, triangular, or quadrangular pyramids in shape (col. 6, line 66-col. 7, line 2). The thickened peripheral edge appears to be approximately twice as thick as the thickness of the non-peripheral backing (Figures 1, 2, and 11). The resin for the resin backing may be PVC, EVA, butadiene rubber, or a polyolefin (col. 7, lines 30-35). The carpet base is made of fibers such as polyester or cotton and may be a needlepunched or tufted carpet (col. 7, lines 35-39). The figures show a cut loop pile fabric. Figure 7 shows rounded corners.

With respect to claim 63, it is asserted that the limitation of "improved tear resistance" is inherently met since said limitation is a relative limitation. With respect to claims 54 and 79, it is noted that Fujii teaches the prior art carpet mats have a non-peripheral carpet backing thickness of 1-2 mm (col. 1, lines 51-52). Thus, it can be seen that Fujii anticipates claims 38-46, 48, 49, 51, 54-56, 58, 63-71, 73, 74, 76, 79-81, and 83.

With respect to the limitations describing the method of making the mat recited in claims 21 and 36, as noted above, said limitations are not given patentable weight at this time. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. It is the Examiner's position that the carpet mat of Fujii is identical or only slightly different than the presently claimed mat prepared by the method presently claimed, because both mats have a fabric layer bonded to an rubber backing having an integral thickened periphery. If the product in the product-by-process claim is the same as or an obvious variant from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964. The burden has been shifted to the Applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289. Thus, claims 21 and 36 are rejected as being anticipated by or obvious over the cited Fujii patent.

15. Claims 47, 50, 52, 53, 72, 75, 77, and 78 are rejected under 35 USC 103(a) as being unpatentable over the cited Fujii patent in view of US 5,524,317 issued to Nagahama et al.

Fujii lacks specific teachings to the fabric and substrate basis weights. However, said weights are well known in the carpet mat art. For example, Nagahama teaches a carpet mat having a carpet face and a elastomeric backing, wherein said carpet face comprises a carpet substrate having pile yarns tufted, sewn, hooked, or the like therein (col. 6, lines 49-55). The substrate may be a woven, nonwoven, or knit fabric of synthetic fibers such as polyesters and polyolefins (col. 6, lines 28-37). Said substrate has a basis weight of 50-500 g/m<sup>2</sup> (col. 6, lines 45-47). Thus, it would have been obvious to one skilled in the art to employ a carpet substrate



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and carpet fabric having the presently claimed basis weights since said weights are known in the art to be suitable for the intended use. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416. Therefore, claims 47, 50, 72, and 75 are rejected as being obvious over the cited prior art.

Similarly, Fujii lacks a specific teaching to nitrile rubber or SBR. However, Nagahama teaches the elastomeric backing may be a nitrile or styrene-butadiene rubber (col. 6, lines 64-66). Thus, it would have been obvious to choose the presently claimed rubbers since said rubbers are known in the art to be suitable for the intended use. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416. With respect to the claimed hardness values, it is asserted that these values will be met upon the use of the nitrile rubber or SBR, since said hardness is an inherent physical property of the cured material. The burden is upon Applicant to prove otherwise. Therefore, claims 52, 53, 77, and 78 are rejected as being obvious over the cited prior art.

16. Claims 59-62 and 84-87 are rejected under 35 USC 103(a) as being unpatentable over the cited Fujii patent.

Although Fujii does not explicitly teach the claimed edge shape, it is asserted that said claims are obvious over Fujii. Specifically, it would have been obvious to one skilled in the art to change the shape of the carpet edge from a slope to a clean or concave edge, since a change in shape is generally recognized as being within the level or ordinary skill in the art. *In re Dailey*,

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149 USPQ 47. Therefore, claims 59, 60, 84, and 85 are rejected as being obvious over the cited Fujii patent.

With respect to claims 61, 62, 86, and 87, it is noted that Fujii is silent with respect to the carpet mat dimensions. However, it is deemed that said claims are obvious over Fujii.

Specifically, it would have been obvious to one skilled in the art to manufacture a carpet mat with the claimed dimensions, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. Therefore, claims 61, 62, 86, and 87 are rejected as being obvious over the cited Fujii patent.

17. Claims 22, 52, 53, 57, 77, and 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Fujii patent in view of GB 2 275 869 issued to McCordall et al.

Fujii lacks a specific teaching to the presently claimed holes or perforations. However, said perforations are well known in the carpet mat art. For example, McCordell discloses a floor mat having a pile surface and a rubber backing, such as nitrile rubber having a hardness value of 45-70 IRHD (abstract and page 3, 1<sup>st</sup> paragraph). The mat has perforations for ease of washing (abstract). Thus, it would have been obvious to one skilled in the art to perforate the floor mat of Fujii in order to produce an easily washed mat. Additionally, it would have been obvious to choose the nitrile rubber disclosed by McCordell since said rubber is known to be suited for the intended use. Therefore, claims 22, 52, 53, 57, 77, and 78 are rejected as being obvious over the prior art.

***Conclusion***

18. The art made of record and not relied upon is considered pertinent to applicant's disclosure.

19. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Cheryl Juska whose telephone number is 703-305-4472. The Examiner can normally be reached on Monday-Friday 10am-6pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

  
CHERYLA. JUSKA  
PRIMARY EXAMINER